

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

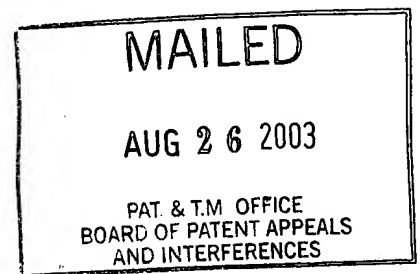
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte CHANDRA V. MOULI

Appeal No. 2003-0596  
Application No. 09/379,092

ON BRIEF



Before WARREN, WALTZ, and POTEATE, Administrative Patent Judges.  
WALTZ, Administrative Patent Judge.

**REMAND TO THE EXAMINER**

Upon a review of the file record for this application, we determine that this appeal is not ripe for decision at this time. Accordingly, we remand this application to the jurisdiction of the examiner to take action consistent with the following remarks.

The examiner rejected claims 1-3, 7, 33, 35 and 39 under 35 U.S.C. § 102(e) as anticipated by Hong<sup>1</sup> in an Office action dated

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<sup>1</sup>U.S. Patent No. 6,030,882, issued Feb. 29, 2000, and filed on Dec. 30, 1998.

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Mar. 28, 2001 (Paper No. 7). This Office action also included a rejection of claims 5-6 and 36-38 under 35 U.S.C. § 103(a) as unpatentable over Hong, with Official Notice taken by the examiner that argon or oxygen are art recognized equivalent elements used to form an oxygen enhanced region (*id.*).

Applicant submitted a response to this rejection (amendment dated Apr. 23, 2001, Paper No. 8). Consequently, the examiner made a final rejection of claims 1-3, 5-7, 33 and 35-39, noting that "[t]he previous rejections stand." Final Office action dated June 28, 2001, Paper No. 9, paragraph 1.

Appellant timely appealed from this final rejection (Notice of Appeal dated Aug. 28, 2001, Paper No. 12; and the Brief, dated Sep. 28, 2001, Paper No. 13, page 1).<sup>2</sup> Appellant's Brief contained arguments only against the rejection of the claims as anticipated by Hong (Brief, page 8, Section VI; page 9, Section VIII, part A; and page 10, Section VIII, part B). Appellant was aware of the pending final rejection under 35 U.S.C. § 103(a) since it was mentioned at two places in the Brief (pages 9 and 10). However, appellant chose not to present any arguments with respect to this rejection under section 103(a).

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<sup>2</sup>We note that appellant mistakenly refers to the date of the final rejection as Jan. 30, 2001, when the correct mailing date of this action is June 28, 2001 (see Paper No. 9).

In the Answer, the examiner merely repeated the two pending rejections, the first rejection including claims 1-3, 7, 33, 35 and 39 under 35 U.S.C. § 102(e) over Hong (Answer, page 3) and the second rejection including claims 5-6 and 36-38 under 35 U.S.C. § 103(a) over Hong, further citing Batra<sup>3</sup> as evidence to support the Official Notice taken in the final rejection (Answer, page 4). In response to this Answer, appellant submitted a Reply Brief dated Mar. 4, 2002, Paper No. 15, but again failed to present any arguments with respect to the rejection based on 35 U.S.C. § 103(a).

It is clear from 37 CFR § 1.192(d) (1997) that appellant is to be notified by the examiner whenever the Brief does not comply with any of the requirements of 37 CFR § 1.192(c) (2000), and especially where appellant has failed to respond to a ground of rejection, in order to avoid dismissal of the appeal for inadvertent non-compliance with the rule by appellant with respect to one or more grounds of rejection. See *Manual of Patent Examining Procedure (MPEP)*, §§ 1206 and 1215.04, pages 1200-8 through 1200-15 and 1200-40 and 1200-41, 8<sup>th</sup> ed., Aug. 2001).

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<sup>3</sup>Batra et al. (Batra), U.S. Patent No. 6,127,242, issued Oct. 3, 2000, filed Oct. 24, 1994.


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Accordingly, we remand this application to the jurisdiction of the examiner to notify appellant that he must correct the defect of not addressing the ground of rejection based on section 103(a) by filing a brief (in triplicate) in compliance with 37 CFR § 1.192(c), with a period of one month within which to file the amended brief. If appellant does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed. See 37 CFR § 1.192(d) (1997).

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This application, by virtue of its "special" status, requires an immediate action, *MPEP* § 708.01 (D). It is important that the Board be promptly informed of any action affecting the appeal in this application.

## REMANDED

  
Charles F. Warren  
Administrative Patent Judge

Thomas A. Waltz  
Thomas A. Waltz  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS  
AND  
INTERFERENCES

Linda R. Poteate  
Administrative Patent Judge

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